

USSN 10/068,686
Amendment in Response to August 4, 2004 Final Office Action

REMARKS

In the August 4, 2004 office action, the Examiner objected to the drawings on grounds that they did not show every feature of the invention. Specifically, the Examiner argued that the claim 7 & 8 features of "the entire window extends beyond the frame perimeter" is not shown in the figures, and the claim 14, 17 and 24 feature of "an opening in the wall of the structure" was not shown either.

In addition, the Examiner objected to claims 5, 6 and 8, suggesting that the word "window" be changed to "multi-task window".

The Examiner rejected claims 7 and 8 under 35 USC 112, 1st paragraph, stating that the features "substantially the entire multi-task window extends beyond the frame parameter" and "a tab remains within the frame perimeter when the window extends beyond the frame perimeter" were not enabled by the original specification.

The Examiner also rejected claim 12 under 35 USC 112, 2nd paragraph, on grounds that the term "and/or rendered the claim indefinite.

As to the merits over the prior art, all pending claims were rejected as being obvious over USP 5,253,051 to McManigal in view of USP 3,896,589 to Mitchell.

Claims 2, 5-6, 8, 12 and 14-31, are being submitted for the Examiner's consideration in view of the remarks presented herein.

Amendments to the Specification

The specification has been amended to correct spelling and grammatical errors. No new matter is believed to have been introduced by these amendments.

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Amendments to the Claims

Claims 5, 6 and 8 have been amended to recite "multi-task" window, and claims 7 and 9 have been canceled. Furthermore, claim 8 has been amended to depend on claim 6. It is therefore submitted that all non-prior-art-based objections and rejections of claims 5-9 have been overcome.

Claim 12 has been amended to eliminate the "and/or" language which the Examiner rejected under 112, 2nd paragraph.

Objection to the Drawings under 1.83(a) re: Figs. 14, 17 & 24

The Examiner objected on grounds that "an opening" in the wall structure was not shown. It is respectfully submitted that the objection should be withdrawn because (a) Fig. 1 shows an opening in a wall structure, and (b) even if Fig. 1 is considered not to show this, the concept of a 'window in a wall structure' certainly is a concept that anyone, and not just 'persons skilled in the art' can comprehend.

As to (a), Fig. 1 clearly shows the window unit 100 of the present invention which forms "an opening in a wall or building for admission of light and air"¹. The window unit has two larger sash windows 130 that are "sufficient to close the window unit 100."² As seen in Fig. 1, the two larger sashes are overlapped, and so window screens (the cross-hatched, 'shaded' area), representing an opening, may readily be seen.

¹ See Specification at p. 2, lines 8-9

² See Specification at p. 2, lines 27-28

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As to (b), it is submitted that one skilled in the art generally understands the concept of an opening in an wall or building created by a window sash that can slide, either horizontally or vertically.

REJECTION UNDER 35 U.S.C. §103(a):

Claims 2, 5-6, 8, 12 and 14-31 were all rejected under 35 U.S.C. § 103(a) as being unpatentable over USP 5,253,051 ("McManigal") in view of USP 3,896,589 ("Mitchell"). The rejection is traversed.

Independent claims 14, 17, 19 and 21 all recite "a window frame disposed in a wall of a structure" (emphasis added). Each of these independent claims also calls for a window "housed" or "movable" in the window frame.

I. McManigal teaches away from a window in a wall

In contrast, McManigal is directed to a display (such as a plasma display) for mounting on an interior wall of the building; McManigal discloses no window frame in a wall of a structure. Indeed, McManigal does not disclose a window at all, let alone one that is either "housed" or "movable" in the window frame. Moreover, McManigal specifically *teaches away* from a window frame disposed in wall of a structure:

It is a major object to provide an artificial window construction or constructions . . . Basically, the apparatus of the invention comprises: a) a frame having window room configuration to be supported within a room, b) video means including a display encompassed by the frame . . .³

³ USP 5,253,051 at col. 1, lines 31-36 (emphasis added)

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[the] frame 12 has a room window configuration . . . It is configured to be supported within a room chamber, the interior of which is indicated at 80.

An inspection of McManigal's figures further bears this out. McManigal's Figs. 2 & 2a show a building wall 81 separating a building interior 80 from a building exterior 82. McManigal's display 10 clearly is not mounted in a wall of the structure, as recited in each of the pending independent claims, but only in the interior of the structure. At most, McManigal only discloses placing a display on an interior wall.

Given that the entire purpose of McManigal is to provide a display in the interior of a building wall (albeit, in one embodiment, for the purpose of showing what is on the other side of the wall), it is submitted that one skilled in the art would not modify McManigal to place the display in the wall of the structure itself. For this reason alone, it is submitted that all the pending claims define over McManigal in view of Mitchell.

Furthermore, given that the entire purpose of McManigal is to provide an "artificial window" when a real window is not feasible or desired, it is submitted that McManigal actually *teaches away* from using any kind of window:

From the foregoing it will be seen that the invention allowed many of the advantages of a window looking out onto a very interesting outdoor scene where there is no window.⁴

In other words, McManigal deliberately choose an arrangement that eschews any kind of opening in the wall. If the final rejection is maintained, the Examiner is kindly asked to explain (a) how McManigal can be considered to disclose a window frame in a wall of a structure; and (b) how McManigal can be considered to disclose a window at all, in view of the unambiguous teaching away from any kind of window.

II. The alleged motivation to modify McManigal as taught by Mitchell does not exist

On page 5 of the office action, the Examiner concedes that McManigal does not teach the following features:

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- (1) "the window pane permits viewing through the wall of the structure" (claim 21);
- (2) "the multi-task window moves along a horizontal window unit axis" (claim 5);
- (3) "the window is capable of creating an opening in the wall of the structure" (claim 14)⁵;
- (4) "the window is capable of forming an opening in the wall" (claim 24); and
- (5) the multi-task window moves along the window frame" (claim 25).

For all of these features, The Examiner turns to Mitchell and argues that the (sole alleged) motivation "to have modified the McManigal . . . window . . . in view of the teaching in the Mitchell reference" is that it "would provide ventilation within and outside the room." (emphasis added).

This alleged motivation is non-existent, if not utterly contrary to McManigal. First, it is noted that McManigal *already* has some form of ventilation – "Referring back to Fig. 1, an air blower 15 blows air to emanate from a slit 15a in the sill."⁶ It is therefore submitted that one skilled in the art would not turn to Mitchell for the purpose of ventilation, as asserted by the Examiner.

Second, as stated above, the whole point to McManigal is to provide a view *without* a window. McManigal's provides improved scenery for "windowless offices", "basements which have no windows" and buildings with "light wells that do not afford interesting views."⁷ McManigal's solution is to hang a display on the interior wall of a room and show images on that display. None of this entails, or otherwise suggests to one skilled in the art to seek additional ventilation. Indeed, since McManigal's stated purpose is to use a display (i.e., an artificial window) instead of a window, "ventilation" cannot form a motivation to modify McManigal.

If the final rejection is maintained, the Examiner is kindly asked to justify the alleged 'ventilation' motivation given that McManigal already has ventilation, and (b) McManigal teaches away from having an window opening in the wall of the structure.

III. Even if one were to modify McManigal in the manner suggested by the Examiner, one still would not arrive at the invention of pending independent claims 14, 17, 19 and 21.

⁴ UPS 5,253,051 at col. 5, lines 66 – col. 6, line 2 (emphasis added)

⁵ Pending independent claim 17 recites that the "windows . . . (create) an opening in the wall of the structure"

⁶ USP 5,253,051 at col. 5, lines 49-50

⁷ USP 5,253,051 at col. 1, lines 10-15.

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McManigal discloses a display mounted on the wall, and surrounded by a window frame. The Examiner notes that Mitchell teaches "two sash windows . . . capable of moving along a horizontal window unit axis" and suggests that it would have been obvious "to have modified the McManigal sash window capable of moving along a horizontal window axis."

It is submitted that if such modifications were made to McManigal, the resulting device would simply be a display that moves along the window frame (which itself hangs on an interior wall of the structure). One still would not have (1) a window frame disposed in a wall of a structure (claims 14, 17, 19 & 21), (2) an opening in the wall of the structure (claims 14 & 17), and (3) a window pane that permits viewing through the wall of the structure (claim 21). Simply modifying the McManigal window frame so that the display moves along the window frame does not automatically result in any of these enumerated, claimed features. Accordingly, even if the change to McManigal suggested by the Examiner was made, one still would not arrive at the invention of any of the pending independent claims.

If the final rejection is maintained, the Examiner is kindly asked to explain how and why the feature/function that the Examiner has chosen to import from Mitchell ("capable of moving along a horizontal window") would automatically lead to the following three features: (1) a window frame disposed in a wall of a structure (claims 14, 17, 19 & 21), (2) an opening in the wall of the structure (claims 14 & 17), and (3) a window pane that permits viewing through the wall of the structure (claim 21).

IV. Only by hindsight could the Examiner have suggested that McManigal be modified by Mitchell

McManigal merely discloses a display that is: (1) mounted on an interior wall of a room, (2) framed to have the appearance of a window frame, (3) configured to receive signals comprising scenery; and (4) provided with a detector to locate a viewer in the room and change the scenery perspective accordingly. Thus, the Examiner began with a reference that simply taught a display mounted on a wall, and concluded that it would be obvious to modify such a reference to arrive at (a) a window unit including a window frame mounted in a wall of a structure, (b) the window frame having one or more movable window panes, AND a display. In

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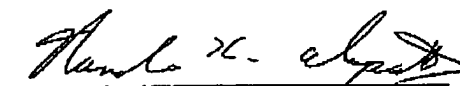
view of the foregoing, and further in view of the fact that the McManigal reference teaches away from a window formed in a wall of a structure, and has no use for a movable display, it is submitted that the Examiner used hindsight in arriving at the final rejection of pending claims 14, 17, 19 and 21.

With respect to all claims not specifically mentioned, it is submitted that these are patentable not only by virtue of their dependency on their respective based claims and any intervening claims, but also for the totality of features recited therein.

Reconsideration of the application is requested. Claims 2, 5-6, 9, 12 and 14-31 are believed to be in allowable form and define over the prior art. An early notice of allowance is requested so that the application may proceed to issue. Should the Examiner have any questions or comments regarding the foregoing Amendment and response, he is invited and urged to telephone the undersigned attorney.

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0528.

Respectfully Submitted,

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